

REMARKS

The present application is directed to cosmetic and dermatologic compositions.

By the present amendments, claims 1-9 have been deleted, without prejudice, and claims 10-21 have been added. Claims 10-21 find support throughout the specification and in the claims they replace. It is believed no new matter has been added.

The claims have been rejected under 35 USC 112. The rejection is respectfully traversed.

The first paragraph of 35 USC 112 requires that

[t]he specification shall contain a written description of the invention and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

With respect to the first paragraph of 112, the severability of its written description provision from its enablement provision was recognized long ago in In re Ruschig, 154 USPQ 118 (CCPA 1967). [T]he question is not whether [one skilled in the art] would be so enabled but whether the specification discloses the compound to him, specifically, as something appellants actually invented....If [the rejection is] based on section 112, it is on the requirement thereof that "The specification shall contain a written description of the invention ..." Ruschig at 123.

The issue, as the court saw it, was one of fact: "Does the specification convey clearly to those skilled in the art, to whom it is addressed, in any way, the information that

appellants invented that specific compound?" Ruschig at 123.

Whether a specification contains a sufficient disclosure under 35 USC 112 is one of law; compliance with the written description is one of fact. Utter v. Hiraga, 6 USPQ2d 1709 (Fed. Cir. 1988).

It is well-established that an inventor has a "verbal license," he is his own lexicographer and is free to define his claim terms in any way he chooses. Fromson v. Advance Offset, 219 USPQ 1137, 1139 (Fed. Cir. 1983).

The fundamental issue when determining the scope of a claim, therefore, is how the inventor defined the terms in the claim. This issue is resolved from the perspective of one skilled in the relevant technological area. . . In resolving a dispute as to the scope of a claim, the Court is obligated to consider the patent specification, the other claims in the patent, and the patent's prosecution history. . . The Court may also consider other forms of extrinsic evidence, such as expert testimony. . . or texts, such as dictionaries, explaining usage of the disputed claim terms . . . Lemelson v. US, 6 USPQ2d 657, 1660 (US Ct 1988).

The present disclosure and the claims as amended herein fully comply with the statutory requirement of 35 USC 112, first and second paragraphs. Withdrawal of all rejections under 35 USC 112 is requested.

The claims have been rejected under 35 USC 103(a) as being unpatentable over JP 04099730 or JP 04099771. The Examiner's comments have been carefully considered, and the rejection is respectfully traversed.

The Examiner is of the opinion that it would have been obvious to incorporate flavanoid compounds in a cosmetic composition for preventing the oxidation of ascorbyl compounds. Applicants respectfully disagree. Without any suggestion in the cited references in support of such manipulations, the finding of obviousness is based on pure speculation or the unsupported opinion of the Examiner who relies on a hindsight knowledge derived from Applicants' specification. The Examiner is suggesting an "obvious to try" concept. But, such a concept does not render Applicant's invention as presently claimed unpatentable.

Because chemistry is often an empirical science, it is easy to characterize inventions in the field as being the result of "routine testing" or having been "suggested". However, while obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art" In re Keller, 208 USPQ 871, 881 (CCPA 1981), it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, or suggestion supporting the combination" ACS v. Montefiore, 221 USPQ 929, 933 (Fed. Cir. 1984).

Approaches to obviousness determinations which focus merely on identifying and tabulating "missing elements" in hindsight retrospect "imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge," and "fall victim to the insidious effect of hindsight syndrome where that which only the inventor taught is used against its teacher." Gore v. Garlock, 220 USPQ 303 (Fed. Cir. 1983). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

The instant invention is not obvious over the cited art.

In view of the above, this application is believed to be in condition for allowance.

Favorable consideration is requested.

Respectfully submitted,
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I hereby certify that the foregoing AMENDMENT UNDER 37 CFR 1.111 is being deposited with the United States Postal Services as first class mail in an envelope addressed to Assistant Commissioner for Patents Washington, D.C. 20231 on June 14, 1999.

SPRUNG KRAMER SCHAEFER & BRISCOE

By, Constance J. Herofens

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